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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,339	12/04/2003	Marc Nazare	DEAV2002/0085 US NP	8596
5487	7590	10/04/2006		
ROSS J. OEHLER SANOFI-AVENTIS U.S. LLC 1041 ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			EXAMINER SOLOLA, TAOFIQ A	
			ART UNIT 1626	PAPER NUMBER

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/728,339	NAZARE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Taofiq A. Solola	1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 9/11/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 1,8-12,14 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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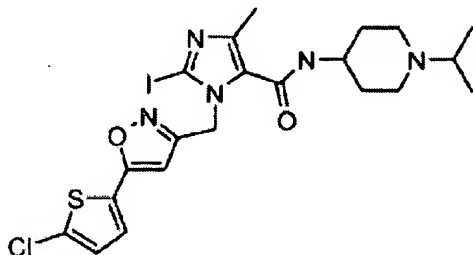
Claims 1, 8-18 are pending in this application.

Claims 13, 15-17 are drawn to non-elected invention.

Claims 2-7 are cancelled

### ***RESTRICTION REQUIREMENT***

In response to the Restriction Requirement, Applicant elects with traverse the invention of group I, claims 1, 8-12, 14, 18. The traversal is on the basis that the newly added claim 18 "is clear and distinct." This is not persuasive for reasons set forth in the Restriction Requirement. In response to Applicant's contention that groups II and III be rejoined, such would be rejoined in accordance with the Rejoinder Clause in the Restriction Requirement. In addition to the election of group I, Applicant also elects the following species:



wherein in formula I, R<sup>o</sup> is

substituted isoxazol-3-yl, R<sub>1</sub> is H, R<sub>2</sub> and G are direct bonds, R<sub>3</sub> is methyl, R<sub>4</sub> is I, Q is methylene, V is piperadine and M is isopropyl. Therefore, claims 1, 8-12, 14, 18 are being examined in part subject to the election made by applicant.

Applicant's arguments filed 9/11/06 have been fully considered but they are not persuasive. Applicant requests the Examiner to perform additional search because no prior art is found, in support thereof MEPE 803,02 is cited. This is not persuasive because MPEP 803.02 state even when no prior art is found examination needs not be extended to cover all the species in a Markush claim. MPEP 803.02 states that examination "will not be extended

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unnecessarily to cover all non-elected species." Examination is required only to "the extent necessary to determine patentability." The Examiner did just that. MPEP 803.02 also requires that examination of the entire invention would be made without serious burden on the Examiner. In the instant case, it would be a serious burden on the Examiner to search all the inventions.

The restriction is still deemed proper and therefore made FINAL.

### ***Status of Claims***

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

In formula I, R1, R2, R3, R4, V, G and M are as defined in claim 1, Q is methylene, R<sup>o</sup> is substituted isoxazol-3-yl, the substituents on the imidazole ring are attached to it as in the elected species. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1, 8-12, 14, 18 are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

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Claims 1, 8-12, 14, 18 are objected to for containing non-elected subject matter. To place the claims in condition for allowance, the claims must be amended within the scope of allowable subject matter set forth above under Status of Claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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A handwritten signature in black ink, appearing to read 'Taofiq Solola', with a stylized, sweeping flourish at the beginning.

**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**

Group 1626

September 29, 2006